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KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**



Application Number: 09/894,904
Filing Date: June 29, 2001
Appellant(s): MONROE, STEVEN C.

David J. Zibelli
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on Jan. 16, 2007 appealing from the Office action mailed on May 01, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| 6,105,127 | Kimura | Aug. 15, 2000 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-50, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,760,746 issued to Schneider (hereinafter referred as Schneider '746).

Claim 21:

Schneider '746 discloses:

Maintaining a whois database in an Internet Domain Names Service system [e.g., Abstract, the unit 120', Fig. 1K and associated texts, the unit 172, Fig. 1m and associated texts, Fig(s). 3-10], comprising:

extracting a plurality of unique identifiers from an audit file, each unique identifier corresponding to a modified domain name record within a registrar database [e.g. the step 610-630, Fig(s). 6a and associated texts, the AutoSearch processing of Fig. 7 and associated texts]; and for each unique identifier:

determining whether a first domain name record that corresponds to the unique identifier exists within the registrar database, if the first domain name record exists, retrieving the first domain name record from the registrar database [e.g., col. 13, lines 31-42; the step 626, Fig. 6a; Fig. 6b and associated texts];

determining whether a second domain name record that corresponds to the unique identifier exists within the who is database, if the second domain name record exists, retrieving the second domain name record from the whois database [e.g., col. 13, lines 21-29; col. 25, lines 27-33; the processing of hyperlink whois request, col. 26, lines 51-56];

comparing the first domain name record to the second domain name record [e.g., col. 13, lines 21 – 63]; and

updating the second domain name record, within the whois database, based on the first domain name record [e.g., col. 35, lines 42-52; the steps: 1010-1030, Fig. 10 and associated texts].

Claim 22:

Schneider '746 further discloses:

The cited feature "deleting a second domain name record if the first corresponding domain name record does not exist". [e.g., col. 29, lines 24-30].

Claim 23:

Schneider '746 further discloses:

The cited feature "adding a first domain name record to the whois database if the second corresponding domain name record does not exist". [e.g., col. 23, lines 10-19].

Claim 24:

The cited feature – discarding duplicate unique identifiers from the plurality of unique identifiers -- is the nature property of unique identifier in a DSN system.

Claim 25:

The cited features – modified domain name record consists of an added domain name record, a deleted domain name record and changed domain name record – are inherent for any modification processing performed on a domain name data item.

Claim 26:

Schneider '746 further discloses:

The cited features - using an indicator to indicate the type of add, delete and change processing corresponding to a unique identifier of an audit file. [e.g., the domain name status indicator, col. 28, lines 21-24].

Claim 27:

Schneider '746 further discloses:

The audit file includes modified domain name information associated with each unique identifier [e.g. the zone files, col. 6, lines 4-7].

Claim 28:

Schneider '746 further discloses:

the plurality of unique identifiers are associated with a time period [e.g., col. 34, line 1-16].

Claim 29:

Schneider '746 further discloses:

tagging the audit file to identify previously extracted unique identifiers [e.g., the Watch list, Fig. 5].

Claim 30:

Schneider '746 further discloses:

The whois database is a copy of registrar database [e.g. the local cache 172, Fig. 1m].

As to claims 31-50, these claims recite the same features as claims 21-30 in form of computer system and computer-readable program product, hence are rejected for the same reason.

**(10) Response to Argument**

Applicant's arguments filed on Jan. 16, 2007 have been fully considered but they are not persuasive.

**The Applicant's Invention:**

A computer-implemented system and method that maintain a registrar "whois" database by using an audit file.

The examiner disagrees with appellant's piecemeal interpretation and arguments against the 35 U.S.C. § 102(e) rejections.

The main arguments against the 35 U.S.C. 102(e) rejections are summarized as following:

1) Schneider is not directed to updating domain name records in a whois database by comparing a first domain name record in a registrar database with a second domain name record in a whois database as required by the claims.

2) Schneider does not disclose extracting a plurality of unique identifiers each corresponding to a modified or deleted domain name record within a registrar database.

In reply to these spurious arguments, it is noted first that the metes and bounds of the claimed "a first domain name record" or "a second domain name record" is not defined in the instant specification, thus, it is open for reasonable art interpretation. In light of prior art, the examiner regards that the claimed first domain name record and the claimed second domain name records are the generic set of all names and address that refer to resource objects on an Internet, wherein each of the resource objects on the Internet is indicated by a network Universal Resource Identifier (URI) that can be access by the Uniform Resource Locator (URL, e.g., Schneider: col. 2, lines 62 – col. 3, lines 5).

Schneider further disclosed that Internet comprises a Domain Name System(DNS) with Domain Name Services (DSN) that provides a mechanism to automatically update, search and extract those distributed network resources being represented by the URIs via the network client resolver software queries at name servers per function calls such as the NET_GetURL( ) or Net_Find Address( ), etc. (e.g., col. 3, lines 62 – col. 4, lines 4).

In addition, the examiner directs appellant's attention to the following excerpts disclosed by Schneider:

*"There are registration services such as the registration of domain names. Domain names are identifiers used for accessing resources and retrieving registrant domain name information.* Resource location of a domain name may be determined by resolving a DNS query and domain name availability may be determined by using a WHOIS service to query an appropriate NIC database. *There are search services to access searchable databases of network resources that are relied upon daily by millions of users. When a client system receives a search request, a query may be sent to a server connected to the Internet to retrieve Uniform Resource Locators (URLs) that satisfy the search request." (col. 6, lines 9-20)"*

*"Resolution requests are most commonly generated in response to input provided to the location field of a web browser. Entering a URL in the location field serves as a means to access content from that URL. Because the location field is critical for accessing resources, the design of such location fields have rivaled much competition and innovation between existing web browser products from companies such as Netscape and Microsoft. Improvements to better track and organize sites of URLs that users have visited such as Bookmark folders, URL history, and the personal toolbar are all examples of functionality designed to help users navigate. Other improvements include spell checking and an autocomplete feature from the URL history as text is entered into the location field." (col. 7, lines 7-20)*

*"The autosearch feature of Microsoft Internet Explorer (MSIE) is another example of an improvement to the location field of a web browser. The details of the autosearch feature is disclosed in U.S. Pat. No. 6,009,459... The '459 patent specifies a mechanism for a computer system to automatically and intelligently determine what a user intended when the user entered text within the location field of a web browser. Often users improperly enter URLs or enter search terms in a user interface element that requires URLs. If the user enters text that is not a URL, the system may first try to construct a valid URL from the user-entered text. If a valid URL can not be constructed, the browser then automatically formats a search engine query using the user-entered text and forwards the query to an Internet search engine." (col. 7, lines 36-52)*

*"Furthermore, the '459 patent specifies a method which provides for automatically deleting prefix terms from input that are identified as not necessary to perform a search based on the determined meaning of the entered input. Directive terms such as "go" or "find" followed by search terms may be entered within the location field. Such users intend for the web browser to locate web pages that are identified by terms within the text. As the directive terms do not contain content that is useful in conducting a search, these prefix terms are dropped from the text." (col. 7, lines 53-58)*

As set forth above, Schneider clearly disclosed the domain name of a registration service in an Internet including extracts (or retrieves) the registrant unique domain name specified in a "WHOIS" query that is communicated between an Internet client/server environment, wherein, the environment is designed to use the claimed domain name space maintenance schema. For example, an existing "autosearch" browser server developed by Microsoft will automatically update (or construct) the improperly entered URL (i.e., a domain name records in the Internet "WHOIS" database query) to a valid URL, thereby, by comparing a first domain name record in a registrar database (e.g., the user entered URL domain name of the browser registrar database) with a second domain name record in the whois Internet database (e.g., the records tracked by the browser and organized into URL history, or bookmark folders or personal toolbar) and extracting a plurality of unique identifiers each corresponding to a modified or deleted domain name record within a registrar database via the Internet DNS (or domain name services) query executed by a web browser.

In addition to the above browser navigation, search, extraction, resolution and registration services, Schneider further disclosed an integrated domain name registration service system (e.g., Abstract) that fully disclosed the argued limitations as shown in Fig(s) 3-10 and associated texts. Thus, in contrary to appellant's arguments, the prior art fully anticipates the claimed limitations.

Based on the discussion above, because applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the

art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections, therefore, it is believed that the rejections on record should be sustained.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Susan Y Chen
Examiner
Art Unit 2161

Conferees:

Apu Mofiz

SPE – AU 2161

Lee, Eddie

Appeal Specialist

EDDIE C. LEE
SUPERVISORY PATENT EXAMINER